



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,925	02/06/2001	Dongsoo S. Kim	67742-13	6190

22504 7590 01/23/2006

DAVIS WRIGHT TREMAINE, LLP
2600 CENTURY SQUARE
1501 FOURTH AVENUE
SEATTLE, WA 98101-1688

EXAMINER

DUONG, FRANK

ART UNIT	PAPER NUMBER
----------	--------------

2666

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

58

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 09/777,925</p>	<p>Applicant(s) KIM ET AL.</p>	
	<p>Examiner Frank Duong</p>	<p>Art Unit 2666</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

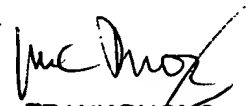
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: _____.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attachment!.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


FRANK DUONG
PRIMARY EXAMINER

Attachment

In the Remarks of the outstanding response filed 10/20/05, on page 10, pertaining the rejection of claims 1-3, 11-13, and 22-32 under 35 U.S.C. 35 § 102 (a) as being anticipated by Makam reference, Applicants argue the instant application inherit the priority dated of September 14, 1994 of the Application No. 09/395,831, to which the instant application is a continuation-in-part (CIP). The argument is based on a rationale that the application 09/395,831 discloses "protection switching is a process ... (working path)" and "switching traffic from the working network path to the protection path when traffic congestion is detected in the working path that exceeds a predetermined threshold". Because of the aforementioned description, the Applicants boldly conclude that a skilled artisan would have recognized the teaching of the application 09/395,831 would be applicable to a virtual private network (VPN). To support the bold conclusion Applicants cited a definition of the VPN straight out from Microsoft Computer Dictionary, 5th ed.

In response Examiner respectfully disagrees. A careful review of the application 09/395,831, Examiner, again, finds neither specific language nor evidence to link the disclosed and claimed invention of the instant application to the prior application to satisfy the written description requirements of 35 U.S.C. 112, first paragraph. Thus, Examiner, contradistinction to the Applicants' argument, asserts the prior application (App. No. 09/395,831) does not disclose the claimed subject matters of the instant application in general and the claimed invention of claims 1-3, 11-13, and 22-32,

specifically. Therefore, the Makam reference is still qualified as the prior and applied art.

On page 11, last two paragraphs, Applicants argue *"the Office Action asserts that a VPN network is inherent in an MPLS network. To that extent, a VPN network is also inherent in the ATM network described in U.S. Application No. 09/395,831, from which priority claimed in the present application"*.

In response Examiner respectfully disagrees and asserts the interpretation of the Makam to inherently include the VPN network in Makam's MPLS network is just. The claimed invention is examined strictly under the guideline of MPEP. Examiner has reviewed and fully understood that "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)". The Rosen et al reference, accompanied the Office Action dated 05/31/05, served as Examiner's extrinsic evidence. On the other hand, Applicants' disclosed and claimed invention must satisfy the written description requirements of 35 U.S.C. 112, first paragraph. Therefore, the instant application does not inherit the prior application's filing date and Makam reference is still qualified as the prior and applied art.

On page 12, first paragraph, Applicants argue *"nothing in Makam suggests any equivalence between traffic congestion and network failure. However, such*

equivalence is stated in the priority document, U.S. Application No. 09/395,831, page 10, lines 20-22.) Thus, claim 1 is allowable for at least two reasons ... over Makam".

In response Examiner respectfully disagrees because the instant application does not inherit the prior filing date of the prior application for the reasons discussed above. In addition, Makam, as clearly pointed out in the Office Action, does indeed disclosed the claimed invention in a manner as claimed. In Makam, the switching between the working path (*Fig. 1; path 1-2-3-4-6-7*) and the protection path (*Fig. 1; path 1-5-7*) of a virtual private network (MPLS network of *Fig. 1*) does indeed based on the detection of traffic congestion exceeds a predetermined threshold. This disputed threshold is clearly discussed on page 19, section 5.5, last paragraph. It is disclosed *"threshold hold K help to minimize false alarms due to ... a buffer overflow".*, contradistinction to the Applicants' argument.

Arguments pertaining the rejection of claims 12, 24, and 29 have been noted. However, they are the same as that discussed above. Therefore, Examiner's response discussed above is also applied.

Due to the arguments are not persuasive and the response filed 10/20/05 fails to place the instant application in a favorable condition for allowance, the rejection is maintained.



FRANK DUONG
PRIMARY EXAMINER